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|--|-------------|-----------------------|---------------------|------------------|
| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
| 10/625,383 | 07/23/2003 | Christopher A. Adkins | 2002-0527.02 | 2361 |
| 21972 | 7590 | 03/07/2005 | EXAMINER | |
| LEXMARK INTERNATIONAL, INC. INTELLECTUAL PROPERTY LAW DEPARTMENT 740 WEST NEW CIRCLE ROAD BLDG. 082-1 LEXINGTON, KY 40550-0999 | | | AUGUSTIN, EVENS J | |
| ART UNIT | | PAPER NUMBER | | 3621 |
| DATE MAILED: 03/07/2005 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.



| Office Action Summary | Application No. | Applicant(s) | |
|------------------------------|------------------------|---------------------|--|
| | 10/625,383 | ADKINS ET AL. | |
| Examiner | Art Unit | | |
| Evens Augustin | 3621 | | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 23 July 2003.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-90 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) Claim(s) _____ is/are allowed.
6) Claim(s) 1-90 is/are rejected.
7) Claim(s) _____ is/are objected to.
8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 23 July 2003 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 7/21/03

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ .
5) Notice of Informal Patent Application (PTO-152)
6) Other: ____ .

Status of Claims

1. Claims 1-90 have been examined.

Claim Rejections - 35 USC § 101

2. Claims 1-58 are rejected under 35 U.S.C. 101 because the disclosed invention is inoperative and therefore lacks utility. The disclosed invention mentions the method of communicating with a database or mechanism, but fails to disclose communication means (network) to enable the method of communicating to a database or mechanism.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(b) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-24, 29-54, 59-70 and 75-86 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takemoto et al. (U.S 20020012541) over Ruder (U.S 4,967,207)

As per claims 1-24, 29-54, 59-70 and 75-86, Takemoto et al. discloses a method comprising of:

- Image forming apparatus with licensed cartridge/toner (page 7, paragraph 124)
- Communicating to a license generating server identification information (page 9, paragraph 151). Since the server stores the identification information and makes use of

it, it is inherent that the server contains a database. The identification information can be in the form of a serial number (page 8, paragraph 140)

- Receiving from the server license information from the server (page 10, paragraph 169).
The license information is the form of a encryption key (page 17, paragraph 266)
- Comparing license information with license information stored in the ink cartridge, and reconcile the information (page 11, paragraph 181, page 17, paragraph 268)
- Determining if the toner level has fallen below a predetermined threshold (page 15, paragraphs 240-241, page 5, paragraph 98)
- The comparing of license information is performed by cartridge/printer (page 11, paragraph 181, page 10, paragraphs 170-175)
- Communicating to the user the status of the transaction and prompting the user for identification related information in a repeated fashion (page 14, paragraphs 223-226)
- The transaction is terminated if license/identification information can not be reconciled (page 10, paragraph 175)
- The comparison of the license/identification information is done between the printer and cartridge (page 11, paragraphs 181-186)
- Printer transmitting the serial number to the server (page 8, paragraph 149)
- Server transmitting the license (verification) information (page 13, paragraph 207)
- Reconciling license information with the printer/toner (page 11, paragraph 181)
- Associating memory with the cartridge (page 14, paragraph 223)
- Comparing identification/serial number in the server to establish a corresponding license information (page 9, 151)

- The printer module also contains memory (page 9, paragraph 158)

Takemoto et al. did not explicitly describe a method that uses a surplus of toner to refill the cartridge. However, Ruder discloses a system that has an ink reservoir (surplus), which can be allocated during normal operation (column 1, lines 6-9). Therefore, it would have been obvious for one of ordinary skill in the art at the time of the applicant's invention to use to allocate a surplus of toner/ink in order to increase the amount of toner/ink available in a printer, and to also to provide more toner/ink and not unduly increase the cost and complexity of the printer (column 2, lines 38-45).

5. Claims 25-28, 55-58, 71-74 and 87-90 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takemoto et al. (U.S 20020012541) over Simon Robert (U.S US 6,816,968) Takemoto et al. did not explicitly describe a method that uses HMAC algorithm. However, Simon Robert discloses a system that uses HMAC algorithm (column 57, line 63). Therefore, it would have been obvious for one of ordinary skill in the art at the time of the applicant's invention to use HMAC algorithm because it is a proven and secure way of transmitting information in an unreliable medium (column 13, lines 29-39).

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Walker et al. (US 6,494,562)
- Childers et al. (US 6,402,306)

- Walker (US 6,312,106)

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Evens Augustin whose telephone number is 703-305-0267. The examiner can normally be reached on Monday thru Friday 8 to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Trammel can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any response to this action should be mailed to:

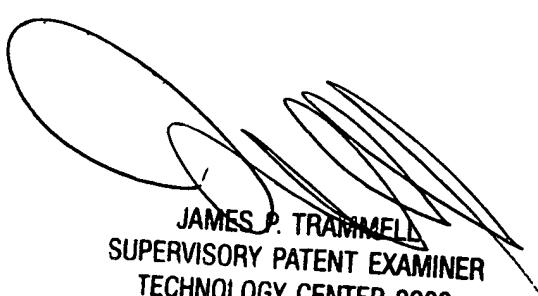
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Or faxed to:

(703) 305 – 5532 (for formal communications intended for entry and after-final communications), or (703) 746-5532 (for informal or draft communications, please label “PROPOSED” or “DRAFT”)

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

Evens J. Augustin
October 28, 2004
Art Unit 3621



JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600